OIPE IAP90 AUG 07 2006 PATENT & TRADEMARK OFFICE

Bd of Appeal

Docket No.: 1080.1092

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2100

In re the Application of:

Yosuke KONAKA

Serial No. 09/781,324 Group Art Unit: 2116

Confirmation No. 9071 Appeal No.: 2006-1215

Filed: February 13, 2001 Examiner: Nitin C. Patel

For: ELECTRONIC APPARATUS AND PROCESSING ABILITY ALTERATION INSTRUCTION APPARATUS

REQUEST FOR REHEARING

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BOARD OF PATENT APPEALS
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Board of Patent Appeals and Interferences
USPTO
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Decision on Appeal mailed June 7, 2006. A Request for Rehearing is due August 7, 2006. The Applicant responds below to certain points raised by the Board in the Decision.

Takizawa And Pole, Either Alone Or In Combination, Do Not Teach The Claimed "Processing Ability Determination Section"

On page 3 of the Decision, the Board indicates that "the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal." For example, the Decision denotes that "Takizawa teaches the invention of claim 1 except that Takizawa turns the device off rather than keeping the device operative under a lower processing ability" (see lines 13-16 on page 8). The Decision further denotes that "Pole teaches changing the processing ability of an electronic device to a lower, but still operative, state upon dectection of a power source change" (see line 21 on page 8 through line 2 on page 9). The Board concludes that "[an] artisan would have been motivated to modify Takizawa to permit lower processing states as taught by Pole instead of requiring a complete shutdown whenever the lower processing states can be handled by the other battery" (see lines 3-6 on page 9).

However, Takizawa and Pole, either alone or in combination, do not teach or suggest a processing ability determination section to determine whether the power supplied from the remaining batteries is an electric power which needs to lower the processing ability as set forth in claim 1, for example.

Takizawa determines whether one of a plurality of battery packs provides a sufficient voltage. There is no determination of whether to maintain a processing ability or lower the processing ability based on the available electric power provided by the batteries.

Pole uses a controller adapted to transition a component from a first performance mode to a lower activity state in response to a power management event. Pole discloses that depending on the desired power consumption, the system may be set to one of multiple performance states. For example, if the system is powered by a battery, the system is placed in a lower performance state to conserve power. Alternatively, if the system is powered by an AC outlet, the system may be placed in a high performance state in which additional heat dissipation devices may be activated.

Thus, Pole does not teach "a processing ability determination section responsive to the removal requirement for a battery from said removal requirement receipt section to determine whether a supplying possible electric power from the remaining batteries is an electric power capable of maintaining a processing ability or electric power which needs to lower the processing ability." Pole does not contemplate a situation where one or more of a plurality of batteries is removed, while processing is carried on with the remaining batteries.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

"Rejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (Fed. Cir. 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

The mere fact, however, that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Conclusion and Summary

Applicant submits that claims 1-42 patentably distinguish over the prior art. Reversal of the Examiner's rejection is respectfully requested.

Respectfully submitted,

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